

REMARKS

The Office Action of July 22, 2009 and the references cited therein have been carefully reviewed. Favorable reconsideration and allowance of the claims are requested in view of the foregoing amendments and the following remarks.

I. Claim Status, and Amendments

Applicants thank Examiner Simmons for his assistance during the telephone interview with the undersigned on January 19, 2010. The claims have been amended in the manner discussed in the interview. Further discussion of the substance of the interview can be found below.

Claims 1-6, 8-13, and 16-20 were pending in this application when last examined. Claims 8-13, 16, 17, and 20 have been withdrawn as non-elected subject matter. Claims 1-6, 18, and 19 have been examined on the merits and stand rejected.

The indication of allowable claims in item 5 of the Office Action Summary is erroneous, since none of the claims have been allowed.

In the response filed May 1, 2009, Applicants traversed the election of species requirement on the grounds that the species are not "mutually exclusive" as required by

MPEP § 806.04(f), because it is possible to have more than one auxiliary component in the composition at a time.

In reply, the examiner maintained the requirement on the grounds that is possible for the composition to only contain one auxiliary component to the exclusion of all others, since in claim 1, the composition can be limited to one auxiliary component. The examiner also argues that claim 1 contains limitations for a first but not a second species, while a second claim contains limitations of a second species and not the first. The examiner notes that claim 12 (which depends on claim 5) contains the presence of a tackifier and does not contain any limitation regarding a pigment, while claim 6 contains the presence of a pigment at 1 - 20% wt. and does not contain any limitation regarding a tackifier. Applicants respectfully disagree.

The claims are open-ended and include the recitation of "one or more auxiliary components". As such, the claims recite and clearly contemplate the possibility of having more than one auxiliary component in the composition at a time. This stands in contrast to examiner's position that claim 1 contains limitations for a first but not a second species. Again, this is not a situation where one auxiliary component is present to the exclusion of all others.

For instance, as discussed in the last response, even for different examples of the same type of auxiliary component, it is possible to have more than one. Taking the example of pigments, a composition may contain both titanium oxide and mica titanium. As to different types of auxiliary components, the claimed composition can contain both a pigment and a methacrylate copolymer as a pigment dispersant, and a dye, and a tackifier, etc.

Thus, this is not a situation where one auxiliary component is present to the exclusion of all others. As such, it is believed that the claims are not directed to different species, but are simply of different scope, namely broader claims and narrower claims, the narrower claims simply adding further features. The present application does not present a situation where auxiliary components are mutually exclusive.

Further, the examiner seems to be taking the position that the claims contain contradictions, for example claim 12 versus claim 6 (which depends on claim 5). In reply, Applicants have amended the claims in a manner believed to alleviate the examiner's concerns and to simplify the claim construction.

Lastly, it is unclear why method claim 20 was withdrawn, since it is clearly directed to a method of using

the tooth coating composition of claim 1. It is generic in nature and encompasses all of the species.

Thus, withdrawal of the election requirement is requested.

In the event that the Office maintains the requirement, then kindly consider and examine additional species, upon a determination of allowance of the generic claims, per U.S. election of species practice. In this regard, the present amendment is believed to overcome the outstanding rejections for the reasons noted below.

By way of the present amendment, claim 1 has been amended to incorporate subject matter from claims 2-4 (now cancelled).

Claim 5 has been amended to define the pigment along the lines of previous claim 6, and claim 6 is amended to define the amount of pigment.

Withdrawn claims 8-13 have been amended to depend, either directly or indirectly, on claim 1. Likewise, the method of withdrawn claim 20 has been amended in a non-narrowing manner to clarify that it uses the tooth coating composition of claim 1.

For the reasons discussed above, all of the claims are believed to be generic, i.e., none exclude the presence of

titanium oxide (elected species), and thus all of Applicants' claims read on (encompass) the elected species.

No new matter has been added by the above amendments.

Claims 2-4 and 14-19 have been cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Claims 1, 5, 6, 8-13, and 20 are pending upon entry of this amendment, and these claims define patentable subject matter warranting their allowance for the reasons discussed herein.

## **II. Foreign Priority**

Applicants have claimed priority from their corresponding application filed in Japan, and a certified copy of the priority application should be of record at the USPTO. Accordingly, please acknowledge the receipt of Applicants' papers filed under Section 119.

## **III. Claim Objections**

On page 3 of the Office Action, claim 4 has been objected to for being of improper dependent form for failing to further limit the subject matter of a previous claim. The

examiner argues that the 31 % in claim 4 does not fall within the limitation of 1 to 30% in claim 2. The objection is traversed.

As discussed in the interview, claim 4 refers to the total content of both the shellac and resin with respect to the 10-31% recitation. As to this range of 10-31% as the total amount of shellac and rosin in claim 4, since the maximum total amounts of shellac and rosin in claim 2 is 2%-60%, or the maximum total amounts of shellac and rosin in claim 3 is 10%-45%, the 10-31% recitation, which is the most effective range of the total amount of shellac and rosin, as described claim 4, is included in the range of maximum total amounts of shellac and rosin in claim 2 or 3. Thus, there is no contradiction. Further, the present amendment clarifies this point by amending claim 1 to incorporate subject matter from claims 2-4 (now cancelled).

For these reasons, there is no inconsistency in the ranges of the various components in the claims. Withdrawal of the objection is requested.

#### IV. Prior Art Rejections

Claims 1 and 18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by US 5,213,615 for the reasons on pages 3-4 of the Office Action.

Claims 1, 5, 6, and 18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by US 2002/0119105 for the reasons on pages 4-5 of the Office Action.

Claims 2-4 and 19 have been rejected under 35 U.S.C. § 103(a) as being obvious over US 2002/0119105 in view of US 5,213,615 for the reasons on pages 5-6 of the Office Action.

These rejections are respectfully traversed and will be discussed together below.

As discussed in the interview, the present amendment overcomes the anticipation rejection of claims 1 and 18 over US 5,213,615 and the anticipation rejection of claims 1, 5, 6, and 18 over US 2002/0119105 by amending main claim 1 to incorporate subject matter from claims 2-4, which were not included in these rejections. For this reason alone, the anticipation rejections are untenable and should be withdrawn.

Further, as to the rejections of claims 2-4 and 19 over US 2002/0119105 in view of US 5,213,615, it should be noted that claims 2-4 and 19 have been cancelled and incorporated into main claim 1. Claim 1, as amended, now recites the most effective ranges of shellac, rosin and the total amount of both in the entire composition. Applicants traverse the rejections on the grounds that they do not apply to claim 1, as amended.

The examiner contends that shellac and rosin are disclosed as the coat-forming components in US 2002/0119105.

However, in US 2002/0119105, rosin is only listed as an example of the resin used as a dispersant of mica titanium. There is no suggestion to use it in combination with shellac. It is believed that US200210119105 does not disclose or suggest the use of shellac and rosin simultaneously as the coat-forming components.

Further, as acknowledged by the examiner at page 6 of the Office Action, neither reference discloses or suggests the rosin at the claimed concentrations; nor do they suggest the claimed concentrations of rosin and shellac. Indeed, neither reference discloses or suggests the most effective range of shellac and rosin, as now recited in main claim 1, i.e., rosin in a range of 5 wt.% to 25 wt.% and shellac in a range of 5 wt.% to 20 wt.% in the entire composition. Nor do the references disclose or suggest the total content of the shellac and the rosin is in a range of 10 wt.% to 31 wt.% in the entire composition, as recited in claim 1. According to the instant application, the most effective ranges of shellac and rosin were discovered by laboratory work as described in the examples in the application.



Nonetheless, the examiner takes the position that it would have been routine to optimize the amounts of the "other resin" as disclosed in US 2002/0119105 to adjust the amount of rosin to arrive at the claimed ranges.

Applicants respectfully disagree with the Office's position that a person of ordinary skill in the art would reach the composition according to the invention by routine optimization. As the examiner is aware, a particular parameter or variable must first be recognized as a result-effective variable, *i.e.*, a variable which achieves a recognized result, before the determination of the parameter or variable might be characterized as routine or obvious. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); See also *M.P.E.P.*, Eighth Ed., Rev. 7 (July 2008) at § 2144.05, II, A, B.

However, there is no such recognition or suggestion of the significance of rosin in the references. Therefore, Applicants respectfully submit that it would not have been a matter of routine optimization to arrive at the claims, as alleged by the examiner.

For the above reasons, main claim 1 is believed to be novel and patentable over US 5,213,615 alone, and US 2002/0119105 alone, or any combination thereof.

As all of the claims depend, either directly or indirectly, from claim 1, it is believed that the argument in favor of patentability of claim 1 suffices for all of the claims.

For these reasons, the anticipation and obviousness rejections should be withdrawn and they should not be applied to the amended claims.

**V. Conclusion**


Having addressed all the outstanding issues, this paper is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance, and favorable action thereon is requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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